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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/910,415

07/20/2001

Judith P. Meyers

Mask

9645

5179

7590

04/18/2006

PEACOCK MYERS, P.C.

201 THIRD STREET, N.W.

SUITE 1340

ALBUQUERQUE, NM 87102

EXAMINER

SUTTON, ANDREW W

ART UNIT

PAPER NUMBER

3765

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

09/910,415

**Applicant(s)**

MEYERS, JUDITH P.

**Examiner**

Andrew W. Sutton

**Art Unit**

3765

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Applicant's arguments filed 2/28/05 have been fully considered but they are not persuasive. The applicant amends claim 1 to include the masked form in a decorative pattern. This language provides no actual structural limitation and it is purely objective as to what a decorative pattern is. The mask 10 is made of a single piece of material 11 as shown in Fig 2. Honsaker teaches first and second attachment portions 14 and 15 are integrated into the pattern of said mask as the new amended claim 1 and 12 states. The mask 10 is made of a single piece of material 11 as shown in Fig 2. The attachment members 17 are folded inward as shown in Fig. 2 to attached to the eyeglasses 18 as stated claims 9 and 20.

### ***Drawings***

2. The drawings are objected to pursuant to 37 CFR 1.84. Figures 1-5 are presented as photographic images. Photographs, including photocopies of photographs, are not ordinarily permitted in utility and design patent applications. The Office will accept photographs in utility and design patent applications, however, if photographs are the only practicable medium for illustrating the claimed invention. For example, photographs or photomicrographs of: electrophoresis gels, blots ( e.g., immunological, western, Southern, and northern), auto- radiographs, cell cultures (stained and unstained), histological tissue cross sections (stained and unstained), animals, plants, in vivo imaging, thin layer chromatography plates, crystalline structures, and, in a design patent application, ornamental effects, are acceptable. If the subject

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matter of the application admits of illustration by a drawing, the examiner may require a drawing in place of the photograph. Since photographs are not the only practicable medium for illustrating the claimed invention, the drawings must be filed in place of photographs if a reply is made to the instant Office action.

### ***Specification***

3. The amendment filed 2/28/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The claims 9, 20, 23, 26, 28, and 34 introduce the term foldable, folding, or folded which is not supported by the originally filed specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

4. Claims 9, 20, 23, 26, 28, and 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant amended the claims to include the mask being folded or foldable and the process of folding the mask. The applicant fails to disclose the fold being in the originally filed specification or

drawing. The dictionary definition of a fold is, "To bend over or double up so that one part lies on another part." The applicant fails to disclose any two parts being folded over which lie together.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6, 8-14, 17, 19, 21, 23-31, 33-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Honsaker (US 3,237,204). Honsaker illustrates in Fig. 1 a mask formed in a decorative pattern formed of a single piece of a pliable material 11 (Col. 1 lines 18-19). The mask includes a first and second attachment portions 17, which are integrated into the pattern of the mask, for joining to eyeglasses (Fig. 2).

As to claims 8, 19, 33, and 38, Even though product-by-process claims are limited by a process, the determination of patentability is based on the product itself. If the product by process claims is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). In the instant application the mask product as defined in claim 19 is same as the mask product in 10, Figs. 1, 3 disclosed by Olson.

As to claims 2-3, Honsaker teaches (Col. 1 line 18) that the mask can be made of paper and cardboard.

As to claim 6, Honsaker teaches that the visor is made from cutting (Col. 2 line 5).

As to claim 9, as best understood, Honsaker illustrate in Fig. 2

As to claim 10, Honsaker illustrates in Fig. 2 that the mask 10 is bendable which would allow for glasses of various sizes fit in the mask. Secondly, makes it inherent that it would allow various size eyeglasses.

As to claim 11, Honsaker illustrates in Fig. 1 the mask 10 being formed of a single sheet 11.

As to claims 12, Honsaker illustrates in Fig. 1 a mask formed in a decorative pattern formed of a single piece of a pliable material 11 (Col. 1 lines 18-19). The mask includes a first and second attachment portions 17, which are integrated into the pattern of the mask, for joining to eyeglasses (Fig. 2).

As to claims 13-14, Honsaker teaches (Col. 1 line 18) that the mask can be made of paper and cardboard.

As to claim 17, Honsaker teaches that the visor is made from cutting (Col. 2 line 5).

As to claim 21, Honsaker illustrates in Fig. 2 that the mask 10 is bendable which makes it inherent that it would allow various size eyeglasses.

As to claims 23, as best understood, Honsaker illustrates in Fig. 1 a mask formed in a decorative pattern formed of a single piece of a pliable material 11 (Col. 1 lines 18-19). The mask includes a first and second attachment portions 17, which are integrated

into the pattern of the mask, for joining to eyeglasses (Fig. 2). Honsaker illustrates in Fig. 2. that the attachment means 17 are folded inward.

As to claim 24, Honsaker illustrates in Fig. 1 the mask 10 being formed of a single sheet 11.

As to claim 25, Honsaker illustrates in Fig. 1 the mask 10 is made of a substantially flat material.

As to claims 26, as best understood, Honsaker illustrates Fig. 2 the attachment members of the make are folded and attached to the eyeglasses.

As to claim 27, Honsaker illustrates Fig. 1 that the mask is made of a substantially flat material.

As to claim 28, Honsaker illustrates in Fig. 1 that the mask is a substantially flat material and then in Fig. 2 Honsaker illustrates that the attachment members 17 are folded inward which allow them to be attached to the glasses.

As to claims 29, Honsaker teaches (Col. 1 line 18) that the mask can be made of paper and cardboard.

As to claim 30, Honsaker illustrates in Fig. 2 that the mask 10 is bendable which makes it inherent that it would allow various size eyeglasses.

As to claim 31, Honsaker teaches that the visor is made from cutting (Col. 2 line 5).

As to claims 34, as best understood, Honsaker illustrates in Fig. 1 a mask formed in a decorative pattern formed of a single piece of a pliable material 11 (Col. 1 lines 18-19). The mask includes a first and second attachment portions 17, which are integrated

into the pattern of the mask, for joining to eyeglasses (Fig. 2). Honsaker illustrates in Fig 2. that the attachment means 17 are folded inward.

As to claim 35, Honsaker illustrates in Fig. 2 that the mask 10 is bendable which makes it inherent that it would allow various size eyeglasses.

As to claim 36, Honsaker teaches that the visor is made from cutting (Col. 2 line 5).

Claim are 1, 4, 8, 9-11, 12, 15, 18-21, 22-25, 30, 33-35, 37-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Olson (US 5,206,956). Olson illustrates in Fig. 1 and 2 a mask formed in a decorative manner of a single piece of pliable material (Col. 2 line 24). The mask includes first and second attachment means 15 that are integrated in the pattern of the mask, which attach the mask to the eyeglasses.

As to claim 10, 21, 30, 35 Olson illustrates in Fig. 2 that the mask 10 is bendable which would allow for glasses of various sizes fit in the mask. Secondly, Olson states in Col. 2 line 52 that the device fits typically sized glasses. This makes it inherent that the device of Olson would allow various size eyeglasses.

As to claims 8, 19, 33, and 38, Even though product-by-process claims are limited by a process, the determination of patentability is based on the product itself. If the product by process claims is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). In the instant application the mask product as defined in claim 19 is same as the mask product in 10, Figs. 1, 3 disclosed by Olson.



As to claim 4, Olson states (Col. 2 line 34) that the mask is made of plastic.

As to claim 7, Olson states (Col. 2 line 46) that die-cutting is used to form the mask.

As to claim 9, as best understood, Olsen illustrates in Fig. 2 the attachment member 15 is folded inward at 14 to allow for the reception of the eyeglasses.

As to claim 11, Olsen illustrates in Fig. 2 the device is made of a single sheet.

As to claim 12, Olson illustrates in Fig. 1 and 2 a mask formed in a decorative manner of a single piece of pliable material (Col. 2 line 24). The mask includes first and second attachment means 15 that are integrated in the pattern of the mask, which attach the mask to the eyeglasses.

As to claim 15, Olson states (Col. 2 line 34) that the mask is made of plastic.

As to claim 18, Olson states (Col. 2 line 46) that die-cutting is used to form the mask.

As to claim 20, as best understood, Olsen illustrates in Fig. 2 the attachment member 15 is folded inward at 14 to allow for the reception of the eyeglasses.

As to claim 22, Olsen illustrates in Fig. 2 the device is made of a single sheet.

As to claim 23, as best understood, Olson illustrates in Fig. 1 and 2 a mask formed in a decorative manner of a single piece of pliable material (Col. 2 line 24). The mask includes first and second attachment means 15 that are integrated in the pattern of the mask, which attach the mask to the eyeglasses. The attachment means are shown in Fig. 3 to be folded to allow for the reception of the glasses.

As to claim 24, Olsen illustrates in Fig. 2 the device is made of a single sheet.

As to claim 25, Olsen illustrates in Fig. 2 the mask 10 is substantially flat.+

As to claim 34, as best understood, Olson illustrates in Fig. 1 and 2 a mask formed in a decorative manner of a single piece of pliable material (Col. 2 line 24). The mask includes first and second attachment means 15 that are integrated in the pattern of the mask, which attach the mask to the eyeglasses. The attachment means are shown in Fig. 3 to be folded to allow for the reception of the glasses. The mask 10 is folded inward at 14 as shown in Fig. 3.

As to claim 37, Olson states (Col. 2 line 46) that die-cutting is used to form the mask.

Claims 1, 5, 16, 26, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Piper (US 3,823,418). Piper illustrates a mask in Figs. 1 and 2 including a mask 10 formed in a decorative pattern of a pliable material, a first attachment member 34 on one portion of said mask for attachment to a first portion 38 of an eyeglass frame, and a second attachment member 34 on a second portion of the mask for attachment to a second portion 38 of an eyeglass frame. The attachment members are integrated into the design of the mask. The applicant teaches that the mask 10 is made of netting, which is a form of fabric (Col. 1 line 53).

### ***Conclusion***

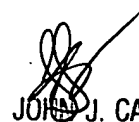
6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew W. Sutton whose telephone number is (571) 272-6093. The examiner can normally be reached on Monday - Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John J. Calvert can be reached on (571) 272-4983. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JOHN J. CALVERT  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

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11 April 2006